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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/874,091	06/04/2001	Deborah Charych	1680.002	6042

7590 11/16/2006

Chiron Corporation  
Intellectual Property Law Department  
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Emeryville, CA 94662

EXAMINER

TRAN, MY CHAU T

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 11/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER
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ART UNIT	PAPER
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20061102

DATE MAILED:

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner for Patents**

Application No.: 09/874,091

Art Unit: 1639

1) Applicant's Appeal Brief filed 8/31/2006 is acknowledged and entered. The Appeal Brief has stated that the amendment filed 12/31/2005 was entered. However due to a formal error on PTOL-303 wherein the amendment filed 02/21/2006 was indicated as being not entered but the attached action correctly indicated that the amendment was entered, and as a result supplemental Advisory Action is being sent to applicant to correct this matter, i.e. the amendment filed 02/21/2006 is entered, and make the record clear.

2) Applicant is not required to response to this supplemental Advisory Action.

4) Any inquiry concerning this communication or earlier communications from the examiner should be directed to My-Chau T. Tran whose telephone number is 571-272-0810. The examiner can normally be reached on Monday: 8:00-2:30; Tuesday-Thursday: 7:30-5:00; Friday: 8:00-3:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Paras, Jr., can be reached on 571-272-4517. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**PETER PARAS, JR.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600**

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/874,091

Applicant(s)

CHARYCH ET AL.

Examiner

MY-CHAU T. TRAN

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**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 21 February 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: NONE.  
Claim(s) objected to: NONE.  
Claim(s) rejected: 1,60-73,79-91 and 97-101.  
Claim(s) withdrawn from consideration: NONE.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See attached sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_.

***ADVISORY ACTION (CONT.)***

***Supplemental Action***

1. The Office Action mailed 03/22/2006 was an Advisory Action. However due to a formal error on PTOL-303 wherein the amendment filed 02/21/2006 was indicated as being not entered but the attached action *correctly* indicated that the amendment was entered, and as a result supplemental Advisory Action is being sent to applicant to correct this matter, i.e. the amendment filed 02/21/2006 is entered, and the attached action mailed 03/22/2006 is reiterate below.

***Application and Claims Status***

2. Applicant's amendment and response filed 02/21/2006 are acknowledged and entered. Claims 1 and 73 have been amended.

***Withdrawn Rejection(s)***

3. The rejections of claims 1, 60-72, and 99-101 under 35 USC 112, first paragraph (new matter rejection) has been withdrawn in light of applicant's amendments of claim 1 wherein applicant has deleted the limitation of "*array does not define a diffraction grating from which a diffracted light signal indicating the presence of a protein bound to one or more of the protein binding agents is obtained*".

4. The rejections of claims 73, 79-91, 97, and 98 under 35 USC 112, first paragraph (new matter rejection) has been withdrawn in light of applicant's amendments of claim 73 wherein

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applicant has deleted the limitation of "*array does not define a diffraction grating from which a diffracted light signal indicating the presence of a protein bound to one or more of the protein binding agents is obtained*".

### ***Response to Arguments***

5. The following prior art rejections are reinstated as indicated in the previous office action mailed 12/21/2005 since applicant has amended claims 1 and 73 to overcome the rejection under 35 USC 112, first paragraph (new matter) in which the limitation of "*array does not define a diffraction grating from which a diffracted light signal indicating the presence of a protein bound to one or more of the protein binding agents is obtained*" has been deleted.

a. Claims 1, 60-61, 63-66 and 99-101 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gustafson et al. (US Patent 5,478,527) and Chenchik et al. (US Patent 6,087,102).

b. Claim 62 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gustafson et al. (US Patent 5,478,527) and Chenchik et al. (US Patent 6,087,102) as applied to claims 1, 60-61, 63-66 and 99-101 above, and further in view of Wagner et al. (US Patent 6,329,209 B1).

c. Claims 67-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gustafson et al. (US Patent 5,478,527) and Chenchik et al. (US Patent 6,087,102) as applied to claims 1, 60-61, 63-66 and 99-101 above, and further in view of Barrett et al (US Patent 5,482,867).

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- d. Claims 73, 79-80, 82-85, 97, and 98 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gustafson et al. (US Patent 5,478,527) and Chenchik et al. (US Patent 6,087,102).
  - e. Claim 81 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gustafson et al. (US Patent 5,478,527) and Chenchik et al. (US Patent 6,087,102) as applied to claims 73, 79-80, 82-85, 97, and 98 above, and further in view of Wagner et al. (US Patent 6,329,209 B1).
  - f. Claims 86-91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gustafson et al. (US Patent 5,478,527) and Chenchik et al. (US Patent 6,087,102) as applied to claims 73, 79-80, 82-85, 97, and 98 above, and further in view of Barrett et al. (US Patent 5,482,867).
6. Applicant's arguments filed 02/21/2006 have been fully considered but they are not persuasive. Applicant's argument is for the rejections of claims 1, 60-73, 79-91, and 97-101 based upon the cited prior art of Gustafson et al. (US Patent 5,478,527).

First, applicant contends that the array of Gustafson et al. is designed for labeled free assay only and Gustafson et al. definition for the term "diffraction grating" *"to include gratings which are formed in one or more immunological steps. For the method of this invention, the diffraction grating is formed directly by the conjugation of the non-light disturbing binding reagent on the insoluble surface with a light disturbing analyte"* (see e.g. col. 4, lines 41-58) would only encompasses the labeled free assay. It is the examiner position that Gustafson et al. definition for the term "diffraction grating" would not only encompasses the labeled free assay but would also include immunoassay step wherein the label analyte bind with the binding pair on

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the surface of the support and the label produces a light signal. Moreover, although the array of Gustafson et al. does not include the claimed limitation of a plurality of fluorescent labeled proteins this deficiency is found in the reference of Chenchik et al.

Second, applicant argues that the expert opinion by Dr. Deborah Charych in the declaration under 37 CFR 1.132 filed 04/06/2005 explained that the combine teaching of Gustafson et al., Chenchik et al., Wagner et al., and Barrett et al. for the rejections above are obvious over the instant claimed array. However, the expert opinion by Dr. Deborah Charych in the declaration under 37 CFR 1.132 is inadequate to overcome the rejections especially with regard to the reference of Gustafson et al. because there is no factual evidence supporting the statement as discussed in paragraph 25 previous office action mailed 12/21/2005. Furthermore, the expert opinion by Dr. Deborah Charych fails to set forth facts that the substrate of Gustafson is designed for labeled free assay only such as a side-by-side comparison of the prior art array and the presently claimed array. (See MPEP § 716.01(c)).

Therefore, the combine teaching of Gustafson et al., Chenchik et al., Wagner et al., and Barrett et al. for the rejections above are obvious over the instant claimed array and the rejections based upon the combine teaching of Gustafson et al., Chenchik et al., Wagner et al., and Barrett et al. are maintained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MY-CHAU T. TRAN whose telephone number is 571-272-0810. The examiner can normally be reached on Monday: 8:00-2:30; Tuesday-Thursday: 7:30-5:00; Friday: 8:00-3:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, PETER PARAS, JR can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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mct

November 3, 2006